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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,384	09/24/2003	Yoshihiro Yazawa	1412-DIV-02	1865
35811	7590	03/31/2005	EXAMINER	
IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP			YEE, DEBORAH	
1650 MARKET ST			ART UNIT	
SUITE 4900			PAPER NUMBER	
PHILADELPHIA, PA 19103			1742	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,384

Applicant(s)

YOSHIHIRO YAZAWA ET AL

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/282,535.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-17-04, 9-24-03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7 to 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 758685 cited by applicant in IDS dated 6-17-04.

3. EP'685 in Table 1-1 on page 7 discloses stainless steel sheet example 3 which meets the composition and equation recited by claim 1. Moreover, steel is processed in substantially the same manner as claimed by applicants by hot rolling, annealing, descaling with acid, cold rolling, annealing and descaling with acid as shown on lines 30 to 40 on page 6. Also example 3 in table 1-2 on page 8 has a ridging grade of 0.5 (equivalent to <5 microns, see lines 25 to 30 on page 4) which overlaps with claimed surface roughness range of 0.3 microns or less.

4. Although grain size of 40 microns or less as recited by claim 7 is not taught by prior art, such would be expected since composition and process limitations are closely met and in absence of proof to the contrary.

5. EP'685 on lines 10 to 18 on page 6 discloses Cu and Ca in wt% ranges which overlap those recited by claims 8 to 10.

6. Although prior art does not teach skin-pass rolling as recited by claim 11, such would be an obvious step to incorporate since it is well known and conventional practice to skin-pass roll steel sheet for further straightening.
7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 409125208 cited by applicant in IDS dated 9-24-03.
8. The English computer translation on pages 1 and 2 for JP'208 discloses a ferritic stainless steel sheet which meets the claimed composition, equation and surface roughness recited by claim 1, and are processed by forging-hot rolling, pickling, cold rolling, annealing and skinpass rolling.
9. Even though prior art process does not teach annealing after hot rolling or pickling after cold rolling, such would not be a patentable difference since the sequence of steps would be a matter of choice well within the skill of the artisan and productive of no new and unexpected results.
10. Even though grain size of 40 microns or less as recited by claim 7 is not taught by prior art, such would be expected since composition, surface roughness and process limitations are closely met and in absence of proof to the contrary.
11. Claims 8 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 409125208 as applied to claim 7 above, and further in view of European patent 758685.
12. Even though JP'208 does not teach the additional alloying elements, Cu or Ca, recited by claim 8 to 10, such would not be a patentable difference. Note that EP'685 teaches an analogous stainless steel sheet with the addition of small amounts of Cu

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and Ca to further enhance steel properties; hence it would be an obvious modification well within the skill of the artisan to further add these elements into JP'208 steel to produce no more than the known and expected effect of such an addition.

13. Claims 12 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 758685 or Japanese patent 409125208 as applied to claims 7 to 11 above, and further in view of applicant's admitted prior art on pages 1 to 3 of his specification.

14. Even though EP'685 or JP'208 does not teach coating steel surface with a resin coating, such step would be obvious to incorporate since it is a well known technique in the art and conventional practice, as taught by secondary reference, for coating steel sheet to further enhance corrosion resistance.

Specification


15. The disclosure is objected to because of the following informalities: In the heading for Table 1 of the specification, the equations listed in the last two columns are incomplete.

Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Yee
Primary Examiner
Art Unit 1742

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